



UNITED STATES PATENT AND TRADEMARK OFFICE

A
UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/694,548	10/27/2003	Stuart G. MacDonald	SGM-521	2408
37282	7590	04/12/2005		EXAMINER
HOWARD J. GREENWALD P.C. 349 W. COMMERCIAL STREET SUITE 2490 EAST ROCHESTER, NY 14445-2408			BOCKELMAN, MARK	
			ART UNIT	PAPER NUMBER
			3762	

DATE MAILED: 04/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/694,548	MACDONALD, STUART G.	
	Examiner Mark W Bockelman	Art Unit 3762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on interview of April 4, 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) 14-17 and 25-37 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-13 and 18-24 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. <u>4-4-2005</u> . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of invention I, species I in the reply filed on 3-1-2005 is acknowledged. The traversal is on the ground(s) that the examiner should include species claims that are dependent upon allowable generic claims. This is not found persuasive because there are no allowable generic claims in the application at this time. The examiner will reconsider such requests upon the indication of an allowable generic claim.

The requirement is still deemed proper and is therefore made FINAL.

Claims 14-17, 25-37 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 3-1-2005.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 13 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 13 appears to include parts of a human body as surfaces in between the thermocouple surfaces. Inclusion of human body parts in claim language is not permitted under 35 USC 101.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-13, 18-20, 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weijand et al USPN 6,470,212 in view of Snell et al USPN 6,108,579 or Greeninger et al USPN 6,067,473. Weijand teaches a thermoelectric charging assembly having thermocouple 252 with temperature sensors 262 and 264, a DC-DC converter and a control element 260 that provide means for transferring thermal energy (sensors 262, 264), means for generating electrical current, means for charging an electrical storage device (256) as well as lines positioned between the charging assembly and storage element (between 254 and 256) and lines between the storage element (256) and the implantable device circuitry 258. The storage device may be a battery or a capacitor (column 13, lines 47-49) and the implant device may be used for delivering drugs, stimulating nerves (would include nerves in brain) or regulating cardiac activity. The examiner considers the the elements 262 and 264 to be the sensors since nothing in the claim indicates that they are different from the means for transferring energy, the device can be used for regulating heart rate, which in turn may regulate body temperature since a more rapidly beating heart burns more calories and transfers heat to the body through the circulatory system. Applicant's power ratings are well known (applicant is using conventional constructs in the specification) and the values

would be recognized as useful in the implant art. The examiner considers the implant assembly of Weijand to lie on an open table and may be "proximate" (noted relative term) to heating elements such as heaters in an physician office that are outside of the range of temperatures between the sensors.

Applicant differs in reciting a means for detecting battery charge and a means for indicating the current is low. Applicant's specification indicates that his means are those of Snell et al. and Greeninger et al. Similarly, the examiner considers it obvious to incorporate these elements into the Weijand et al device, since knowing the current level/ battery state is crucial to sustaining life of those relying upon the Weijand et al pacing device. To have include such features in the Weijand et al device would have been a modification considered obvious to one of ordinary skill for their disclosed advantages.

Claims 21 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weijand et al USPN 6,470,212 in view of Snell et al USPN 6,108,579 or Greeninger et al USPN 6,067,473 as applied to claims 1-13, 18-20, 22-23 above, and further in view of Leysieffer USPN 6,269,266. Applicant differs from the combinations of Weijand et al in view of either Snell et al. or Greeninger et al in reciting that the energy storage element is housed outside of the implantable device that includes the circuitry for performing tasks. Leysieffer discusses the advantages of such an arrangement for replacing rechargeable batteries when they are no longer useful. One of ordinary skill in the art would have recognized the use of such an arrangement in the Weijand et al. device for when its rechargeable battery needs replacing.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark W Bockelman whose telephone number is (571) 272-4941. The examiner can normally be reached on Monday - Friday 8:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on (571) 272 -4955. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MWB

April 7, 2005



MARK BOCKELMAN
PRIMARY EXAMINER